REMARKS/ARGUMENTS

The Pending Claims

Claims 8-12 are pending and are directed to a method of producing a rat embryonic stem (ES) cell.

Amendments to the Claims

The claims have been amended to point out more particularly and claim more distinctly the invention. In particular, claim 8 has been amended to recite that the culturing in steps (A), (C), and (E) takes place on inactivated mouse embryonic fibroblasts, as supported by the specification at, for example, page 16, line 34, and page 17, line 14. Claim 12 has been amended to recite that LIF-free culture medium is used in step (B) of claim 8, as supported by the specification at, for example, page 41, lines 21-33.

Accordingly, no new matter has been added by way of these amendments to the claims.

Summary of the Office Action

The Office rejects claim 12 under 35 U.S.C. § 112, first paragraph, as allegedly containing new matter.

The Office rejects claims 8-12 under 35 U.S.C. § 112, first paragraph, as allegedly lacking enablement.

Reconsideration of these rejections is hereby requested.

Examiner Interview

Applicants thank Examiner Nguyen for the courtesies extended to Applicants' representative Rachel Mejdrich during the telephone interview of August 30, 2011. The remarks set forth herein reflect the discussion during the Examiner interview.

Discussion of the New Matter Rejection

The Office contends that the specification does not provide support for using a rLIF-free culture medium (e.g., a mouse or human LIF culture medium) in the step of dissociating inner cell masses formed from a rat blastocyst that has been cultured in a LIF-free culture medium. Therefore, the Office contends that claim 12 contains new matter.

Claim 12 has been amended to recite that an LIF-free culture medium (as opposed to an rLIF-free culture medium) is used in step (B) of claim 8, which is supported by the specification at, for example, page 41, lines 21-33. Accordingly, claim 12 does not contain new matter, and the new matter rejection should be withdrawn.

Discussion of the Enablement Rejection

The Office contends that the specification only is enabling for the claimed method, wherein culturing steps (A), (C), and (E) are performed on a mitomycin C-treated mouse embryonic fibroblast (feeder cell)-coated dish. The Office contends that the state of the art was unpredictable and that the methods described in the specification and previously submitted Rule 132 Declarations used mitomycin C-treated mouse embryonic fibroblast (feeder cell)-coated dishes during the culturing steps.

In an effort to advance prosecution, Applicants have amended steps (A), (C), and (E) to recite that the culturing takes place on inactivated mouse embryonic fibroblasts as supported by the specification at, for example, page 16, line 34, through page 17, line 14. It is well-known in the art that feeder cells should be mitotically inactivated prior to use. Although mitomycin C treatment is described in the specification as one example of a method to inactivate mitosis (cell division), one of ordinary skill in the art would have recognized that there are many other ways by which cell division can be inactivated (e.g., gamma-ray irradiation).

Applicants believe that the pending claims, as amended, are sufficiently enabled, such that one of ordinary skill in the art would understand how to use the inventive method without an undue amount of experimentation. Therefore, Applicants request that the enablement rejection be withdrawn.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

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